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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,766	04/26/2005	Takashi Kikuchi	81844.0035	2690
26/021 7590 09/09/2008 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER				
HAIDER, SAIRA BANO				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
09/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,766

Applicant(s)

KIKUCHI ET AL.

Examiner

SAIRA HAIDER

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hase et al. (JP 2001-310344).

3. Hase discloses a flexible laminate for use in electronic apparatus, wherein the laminate comprises an adhesive material adjacent to a metallic foil, wherein the adhesive material is a thermoplastic polyimide and the metallic foil is copper foil. The laminate is formed via thermal lamination (pressurized hot forming), wherein a protective material is present between the pressurization side and the copper foil [0005]. The protective material is a non-thermoplastic polyimide and has a thickness of preferably greater than 75 micrometers [0006, 0018].

4. Since the prior art teaches the identical chemical compounds comprising the adhesive layer, metallic foil layer, and the protective material layer, the properties (heat resistance, coefficient of linear expansion and dimensional change) applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The burden shifts to the applicant to show an unobvious difference. Note, that because the reference does not expressly address the properties of the claimed invention, does not mean that the properties are not inherently disclosed. Teaching the same compound(s) inherently discloses the corresponding properties. The references cannot possibly address all of the properties, but implicitly all of the properties are present.

5. Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugitani et al. (JP 10-235784).
6. Sugitani discloses laminate for use as a printed circuit, the laminate comprises a polyimide film layer and metal foil layer, wherein the dimensional change of the laminate after etching is in the range of $\pm 0.05\%$ (abstract and [0007]). The claim merely requires a laminate comprising an adhesive layer and a metallic foil layer. The process of Sugitani results in the formation of the claimed product comprising the claimed dimensional change. Thus, the claimed product appears to be the same or similar to that of the prior art, although produced by a different process.
7. Claims 6-7 are recognized as product-by-process claims, wherein even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).
8. The examiner has provided a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP § 2133.

Response to Arguments

9. Applicant's arguments filed 6/9/2008 have been fully considered but they are not persuasive.

10. Applicants have argued that the Hase reference fails to disclose the claimed coefficient of linear expansion of the heat resistant adhesive material and the protective material, specifically applicant has stated that Hase discloses the aforementioned coefficient as 100 ppm/degree C. The examiner has thoroughly considered applicants' arguments and the support provided, and concludes that the rejection is valid. The claimed coefficient of linear expansion is a function of α_0 , wherein applicant has failed to define α_0 , accordingly, the claims are open. Therefore since prior art teaches the identical chemical compounds comprising the adhesive layer, metallic foil layer, and the protective material layer, the properties (heat resistance, coefficient of linear expansion and dimensional change) applicant discloses and/or claims are necessarily present.

11. Applicants have attempted to refute the inherency argument by citing the specification, wherein the examiner has considered the evidence provided and concludes that it is insufficient to overcome the inherency rejection (Comparative Example 2 and Example 1). As per MPEP § 2112(V), the burden shifts to the applicant to show an unobvious difference, wherein it is necessary that applicant prove that the prior art products do not necessarily or inherently possess the characteristic of the claimed product. Applicants have failed to provide evidence showing that the products of Hase and Sugitani do not necessarily possess the claimed characteristic, i.e. coefficient of linear expansion of the heat resistant adhesive material and the protective material. In the absence of evidence supporting applicants conclusion of a difference between the claimed product and the prior art products, the rejection is maintained and rendered valid. Further, in addition to applicant's failing to show that products of Hase and Sugitani do not necessarily possess the claimed characteristic, the Comparative Example 2 and Example 1 fail to measure the coefficient of linear expansion of the heat resistant adhesive material and the protective material. Rather both examples merely measure the coefficient of linear expansion of the heat resistant adhesive material.

Accordingly, the examples fail to establish that the claimed coefficient of linear expansion is a structural parameter and not an inherent property of the material.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the claimed dimensional change where the laminating temperatures are over 200 °C) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Gemst*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796

Saira Haider
Examiner
Art Unit 1796